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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,836	08/16/2001	Luc Desnoyers	P3030R1C1	5218

9157 7590 11/30/2004

GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

EXAMINER

JIANG, DONG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED OFFICE ACTION

Applicant's amendment filed on 03 September 2004 is acknowledged and entered. Following the amendment, the new claims 41-47 are added.

Currently, claims 22-26 and 33-47 are pending.

Withdrawal of Objections and Rejections:

The prior art rejection of claims 22-26 and 33-37 under 35 U.S.C. 102(e) as being anticipated by Piddington et al., US 6,521,233 B1, is withdrawn for the following reasons:

Claims 22-26, 33-37 were rejected under 35 U.S.C. 102(e) as being anticipated by Piddington et al., US 6,521,233 B1, for the reasons of record set forth in the previous Office Action, paper No. 12. The Piddington patent claims priority to US provisional application 60/130,199, which was filed on 20 April 1999, and disclosed a polypeptide (SEQ ID NO:2) having the same amino acid sequence as the present SEQ ID NO:2. There is no specific and substantial utility disclosed for Piddington's polypeptide of SEQ ID NO:2 in the provisional application 60/130,199. The instant rejection was made in view of the determination that the effective filing date for the instantly claimed invention is 01 March 2000, which is the filing date of the application of PCT/US00/05601, wherein some specific and substantial biological properties of the claimed polypeptide (PRO1484) were disclosed, such as inducing re-differentiation of chondrocytes (Example 36).

In the response filed on 24 May 2004, applicants argue that applicants were in possession of SEQ ID NO:2 prior to 20 April 1999 (which is the filing date of Piddington's US provisional application 60/130,199). This is persuasive because it has been verified that applicants provisional application 60/115,552 filed on 12 January 1999 disclosed the polypeptide sequence of SEQ ID NO:2. Thus, applicants of the present invention were in possession of the polypeptide having SEQ ID NO:2 prior to the effective filing date of the Piddington patent.

Examiner's Amendment

Art Unit: 1646

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Marc Morley on 23 November 2004.

The application has been amended as follows:

Claims 38-47 have been canceled.

Conclusion:

Claims 22-26 and 33-37 are allowable.

Case Suspension

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is **SUSPENDED FOR A PERIOD OF SIX MONTHS** from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Art Unit: 1646

Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Brenda Brumback
BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
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Dong Jiang, Ph.D.
Patent Examiner
AU1646
11/23/04